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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Richard S. Dick

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EXAMINER

COBANOGLU, DILEK B

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/056,236	DICK, RICHARD S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dilek B. Cobanoglu	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/7/2002</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-33 have been examined.

#### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

3. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/794,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only addition to the new application is de-identifying the medical records for the security reasons and using security on private information about the patient when transmitting patient medical information over a network is well known in the art.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being unpatentable by Bessette (U.S. Patent No. 6,775,670 B2).

A. As per claim 1, Bessette discloses a method of searching for medical information executed by one or more computers comprising the steps of:

a) formulating a record request for patient medical information

(Bessette; col. 8, lines 3-7);

b) forwarding the record request to a facilitator, wherein the facilitator reviews the record request and determines which patient record sources to contact (Bessette; col. 6, lines 35-40 and col. 8, lines 7-22);

c) contacting at least one patient record source with a record query electronically requesting information regarding a patient (Bessette; col. 8, lines 3-22);

d) initiating an electronic search of medical records within the patient record source (Bessette; col. 8, lines 3-22);

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e) de-identifying or masking the medical records retrieved from the patient record source (Bessette; col. 11, lines 43-55); and  
f) returning a patient record report containing information held by the patient record source (Bessette; col. 8, lines 20-22), wherein the patient record report and the information returned therein is void of any identifying information (Bessette; col. 11, lines 43-55).

B. As per claim 2, Bessette discloses a method as set forth in claim 1, wherein the information from the patient record source is not released before a physician gives approval (Bessette; col. 8, lines 57-65).

Examiner considers that two doctors in different locations share access to an individual's medical information, studying the record and communicate has the same meaning of one doctor giving the other an approval to view the medical records of the specific patient.

C. As per claim 3, Bessette discloses a method as set forth in claim 1, wherein the information from the patient record source is released automatically (Bessette; col. 8, lines 57-65).

D. As per claim 4, Bessette discloses a method as set forth in claim 1, wherein the facilitator receives the patient record report in a machine readable format augments the report before forwarding it to the requester (Bessette; col. 3, line 60 to col. 4, line 1).

E. As per claim 5, Bessette discloses a method as set forth in claim 1, wherein the facilitator receives the patient record report and normalizes

and augments the report before forwarding it to the requester (Bessette; col. 15, lines 31-38).

F. As per claim 6, Bessette discloses a method as set forth in claim 1, wherein the patient record source is a CIS (Bessette; col. 6, lines 35-40).

G. As per claim 7, Bessette discloses a method as set forth in claim 1, wherein the patient record source is an EMR system or a network distributed shared medical records (NDSMR) (Bessette; col. 4, lines 2-10 and col.7, lines 15-27).

H. As per claim 8, Bessette discloses a method as set forth in claim 5, wherein the search is conducted using software modules installed in a central server, CIS vendor server and a CIS (Bessette; col. 9, lines 3-10).

I. As per claim 9, Bessette discloses a method as set forth in claim 7, wherein if the search determines that the information is available at one of its sources, the information is forwarded in a patient record report to the requestor (Bessette; col. 8, lines 8-22).

J. As per claim 10, Bessette discloses a method as set forth in claim 1, wherein the facilitator receives a patient record report and normalizes that report into a format acceptable to the requestor (Bessette; col. 12, lines 35-51).

K. As per claim 11, Bessette discloses a method as set forth in claim 9, wherein the facilitator receives patient record reports from several patient record sources and combines those reports into an augmented patient

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record report which is forwarded to the requestor (Besette; col. 15, lines 31-38).

L. As per claim 12, Besette discloses the method as set forth in claim 1, wherein the step of de-identifying comprises applying a de-identifying methodology to remove and make certain no personally identifiable information is released (Besette; col. 11, lines 43-55).

M. As per claim 13, Besette discloses a method of searching for medical information executed by one or more computers, the method comprising the steps of:

- a) formulating a record query requesting information regarding an individual (Besette; col. 8, lines 3-7);
- b) forwarding the record query to a patient record source (Besette; col. 6, lines 35-40 and col. 8, lines 7-22);
- c) receiving a patient record report from the patient record source, said patient record report being de-identified to remove identifying information (Besette; col. 8, lines 20-22 and col. 11, lines 43-55).

N. As per claim 14, Besette discloses a method as set forth in claim 13, wherein the patient record source is a computerized patient record manager (Besette; col. 4, lines 2-10).

O. As per claim 15, Besette discloses a method as set forth in claim 14, wherein the computerized patient record manager has contact with other patient record sources and queries those patient record sources before

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responding to the record query with a patient record report (Bessette; col. 7, lines 15-27 and Fig. 3).

P. As per claim 16, Bessette discloses a method as set forth in claim 13, wherein the step of forwarding the record query and the step of receiving a patient record are carried out using secure and encrypted means for communication (Bessette; col. 10, lines 23-26).

Q. As per claim 17, Bessette discloses a method for providing medical information executed by at least one computer, the method comprising the steps of:

- a) receiving a record query requesting information regarding an individual (Bessette; col. 8, lines 3-7);
- b) searching a registry of databases to locate the available records (Bessette; col. 6, lines 35-40 and col. 8, lines 7-22); c) obtaining the records;
- d) de-identifying the records (Bessette; col. 11, lines 43-55); and
- e) forwarding the records to the requester (Bessette; col. 8, lines 20-22).

R. As per claim 18, Bessette discloses a method as set forth in claim 17, wherein the step of receiving a record query comes from a voice telephone call supplemented by a form of authorization and verification (Bessette; col. 8, lines 57-65).



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S. As per claim 19, Bessette discloses a method for determining a location of a patient record created by a healthcare giver at a healthcare facility comprising the steps of:

- a) establishing computer network connectivity between a request facilitator central server and a plurality of healthcare facilities' databases, said plurality of databases being populated by information identifying the healthcare givers using the healthcare facility database and dates for which the healthcare giver was associated with the healthcare facilities' databases to the request facilitator (Bessette; col. 7, lines 15-27 and col. 8, lines 3-22);
- b) transmitting the identifying information from the plurality of healthcare facilities' databases to the request facilitator's central server including information indicating from which health care facility database the identifying information originates (Bessette; col. 8, lines 3-8);
- c) creating a searchable index of the identifying information (Bessette; col. 8, lines 8-16);
- d) submitting a request for the patient record to the request facilitator, the request including information identifying the healthcare giver and an approximate date of creation of the patient record (Bessette; col. 8, lines 3-22, col. 11, lines 10-14 and col. 14, lines 10-16);

- e) querying the searchable index based on the request to determine the location of the patient record (Bessette; col. 8, lines 3-22); and
- f) identifying the location of the patient record (Bessette; col. 8, lines 3-22).

T. As per claim 20, Bessette discloses the method of claim 19 wherein at least one of the plurality of healthcare facilities' databases is operated by a healthcare facility (Bessette; col. 9, lines 3-10 and Fig. 3).

U. As per claim 21, Bessette discloses the method of claim 19 wherein at least one of the plurality of healthcare facilities' databases is operated by a CIS vendor (Bessette; col. 9, lines 3-10).

V. As per claim 22, Bessette discloses the method of claim 19 wherein the identifying information includes the healthcare giver's DEA number (Bessette; col. 11, lines 10-14).

W. As per claim 23, Bessette discloses the method of claim 19 wherein the computer network connectivity is established over the Internet (Bessette; col. 6, lines 45-51).

X. As per claim 24, Bessette discloses the method of claim 19 comprising the additional step of releasing and transmitting the patient record from the location to the request facilitator (Bessette; col. 8, lines 3-22).

Y. As per claim 25, Bessette discloses the method of claim 24, wherein the patient record is de-identified prior to it being transmitted (Bessette; col. 11, lines 43-55).

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Z. As per claim 26, Bessette discloses the method of claim 19 comprising the additional step of releasing and transmitting the patient record from the location to a requestor making the request (Bessette; col. 8, lines 3-22).

AA. As per claim 27, Bessette discloses the method of claim 26, wherein the patient record is de-identified prior to it being transmitted (Bessette; col. 11, lines 43-55).

BB. As per claim 28, Bessette discloses the method of claim 24 wherein the step of releasing and transmitting the patient record is specifically authorized by an appropriate healthcare giver (Bessette; col. 8, lines 57-65).

CC. As per claim 29, Bessette discloses the method of claim 24 wherein the step of releasing and transmitting the patient record is by an appropriate healthcare giver is monitored for timeliness (Bessette; col. 8, lines 43-50).

DD. As per claim 30, Bessette discloses the method of claim 24 wherein the step of releasing and transmitting the patient record is automatically authorized by an appropriate healthcare giver (Bessette; col. 8, lines 57-65).

EE. As per claim 31, Bessette discloses the method of claim 19 wherein the location of the patient record is one of a plurality of computer information systems separate from the healthcare facilities' databases (Bessette; col. 7, lines 15-27).

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FF. As per claim 32, Bessette discloses the method of claim 31 further comprising the step of additionally establishing computer network connectivity between the plurality of healthcare facilities' databases and the plurality of computer information systems (Bessette; col. 7, lines 15-27).

GG. As per claim 33, Bessette discloses the method of claim 32 wherein the healthcare facilities' databases are populated by identifying information transmitted from the plurality of computer systems where the patient records are located (Bessette; col. 11, lines 10-14).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Apparatus and method for processing and/or for providing healthcare information and/or healthcare-related information" 6,283,761 B1, "Prescription creation system" 5,737,539 A, "Prescription management system" 5,845,255 A, "Augmentation system for documentation" 2001/0042080, "Integrated multidimensional database" 2001/0049681, "Medical image capture system and method" 2002/0073429, "Medical records, documentation, tracking and order entry system" 2002/0072934, "Integrated multidimensional database" 6,675,166 B2.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

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10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*DBC*

DBC

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03/30/2006

*C. Luke Gilligan*  
C. LUKE GILLIGAN  
PATENT EXAMINER